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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/819,358

03/28/2001

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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT

PAPER NUMBER

2161

MAIL DATE

DELIVERY MODE

12/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/819,358

Applicant(s)

CHEN ET AL.

Examiner

Etienne P LeRoux

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-22,26-38,40-45 and 47-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-22,26-38,40-45 and 47-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Prosecution Reopened

In view of the Appeal Brief filed on 11/16/2007, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth as detailed below.

Claims Status

Claims 1, 5-22 and 26-38, 40-45 and 47-53 are pending. Claims 2-4 and 23-25, 39 and 46 are canceled. Claims 1, 5-22 and 26-38, 40-45 and 47-53 are rejected as detailed below.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 5-9, 11, 12, 16, 20, 22, 26-29, 32, 33, 35-38, 40, 45-45, 47 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,506,393 issued to Ziarno (hereafter Ziarno) in view of US Pat. No. 6,519,572 issued to Riordan et al (hereafter Riordan).

Regarding claims 1, 22, 35, 36, 38, 45, Ziarno discloses one or more virtual data islands [first donation kettle, second donation kettle 100, Fig 1] partitioned inside the database [Fig 1, donation kettle network] each virtual data island storing client data for a specific client engaged in fundraising [account of charitable organization, col 5, lines 4-10], the client data containing

Art Unit: 2161

one or more constituent records [col. 3, lines 59-65, col 9, lines 57-60], the one or more constituent records including information about individuals [information about a contributor and a donation, col 3, lines 59-65, account number of a contributor, col 9, line 8], the information stored in a plurality of fields [col 9, lines 1-10] wherein each individual is assigned a unique identifier, the unique identifier for an individual being common across the virtual data islands [col 4, lines 21-25, first donation kettle 100 communicates with a second donation kettle 100], a data pool having data from one or more constituent records stored in the one or more virtual data islands [tally of a credit card 145 donation, tally of a debit card 150 donation, tally of a cash donation or combinations thereof for a single contributor or a plurality of contributors, col. 5, lines 10-20], wherein the results of the analysis are used in fundraising campaigns, one or more program codes for analyzing the data pool [software routine, col 5, lines 17-20, statistical software routine, col 5, lines 30-40]

Ziarno discloses in col 9, lines 48-50 a receipt is produced for a single or plurality of donations – the receipt being for tax purposes, col 9, line 67 which reads on a compilation of unique identifiers of the individuals whose records are in the virtual data islands. Ziarno fails to disclose a linking table. Riordan discloses a linking table [col. 10, lines 01-15]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ziarno to include a linking table as taught by Riordan for the purpose of speedy analysis of marketing data and report generation [col. 10, lines 1-15].

Ziarno discloses analyzing data in the data pool, wherein results of the analysis are shared with clients who have data in the data pool [charitable organization col 1, lines 20-40, report, col 5, lines 23-30]

Regarding claims 5, 6, 26 and 27, Ziarno discloses the essential elements of the claimed invention except for the internet. Riordan discloses the internet [col. 2, lines 60-63]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ziarno to include the internet as taught by Riordan for the purpose of implementing an efficient market data collection system [col. 2, lines 60-63].

Regarding claims 7 and 32, Ziarno discloses a charitable organization but does not disclose a nonprofit organization. Official Notice is taken that a nonprofit organization is well-known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ziarno to include a nonprofit organization since the IRS grants nonprofit status to most charitable organizations. *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970).

Regarding claim 8, Ziarno discloses the client is a person [col. 3, lines 59-65]

Regarding claims 9 and 28, Ziarno discloses the results of the analysis are used to identify potential donors likely to donate to one or more charities [col. 5, lines 24-28].

Regarding claim 11, Ziarno discloses a program code for statistical analysis [col. 5, lines 10-22]

Regarding claims 12 and 29, Ziarno discloses a probability of a charitable donation [monthly statement, col.5, line 26]

Regarding claim 33, Ziarno discloses a charitable organization [col. 1, lines 20-25].

Regarding claim 20, Ziarno discloses a common identifier shared by the individual donor records across the virtual data islands [credit card donation col. 3, line 48].

Art Unit: 2161

Regarding claim 16, Ziarno discloses the essential elements of the claimed invention except for automatically updating fields. Riordan discloses automatically updating fields [col. 10, lines 1-15]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ziarno to include automatically updating fields as taught by Riordan for the purpose of maintaining concurrency of data.

Regarding claim 37, Ziarno discloses wherein the client is a charitable organization [col. 3, lines 55-58]

Regarding claims 40, 47 and 53, Ziarno discloses a master island residing in the database and containing a compilation of the fields in the one or more virtual data islands [terminal 120, Fig 1]

Claims 17, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ziarno in view of Riordan as applied to claim 16 above, and further in view of US Pat. No. 6,539,446 issued to Chan (hereafter Chan).

Regarding claims 17, 48 and 49, the combination of Ziarno and Riordan discloses the elements of the claimed invention except for automatic notification of an update option. Chan discloses automatic notification of an update option [col. 2, lines 60-64]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination of references to include automatic notification of an update as taught by Chan for the purpose of notification that a lock failure has occurred [col. 2, lines 60-64].

3. Claims 10, 13-15, 41, 43, 44 and 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ziarno and Riordan as applied to claim 1 above, and further in view of US Pat. No. 6,308,201 issued to Pivowar et al (hereafter Pivowar)

Regarding claims 10, 43 and 50, the combination of Ziarno and Riordan discloses the essential elements of the claimed invention except for an opt-in field indicating whether a client has elected to share data. Pivowar discloses an opt-in field indicating whether a client has elected to share data [Fig 11, 702]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination of references to include an opt-in field indicating whether a client has elected to share data as taught by Pivowar for the purpose of managing concurrent access to records/data to ensure lowest possible response times.

Regarding claim 13, the combination of Ziarno and Riordan discloses the elements of the claimed invention as noted above and furthermore, Pivowar discloses write-access to the field [Fig 5, 512, col 7, lines 29-38].

Regarding claim 14, Ziarno, Riordan and Pivowar discloses the essential elements of the claimed invention as noted above and furthermore, Pivowar discloses the opt-in field accepts a multi-valued variable [Fig, 11, 702].

Regarding claim 15, Ziarno, Riordan and Pivowar discloses the essential elements of the claimed invention and for sharing data with others in different manners [Figs 5 and 11]

Regarding claim 41, Ziarno, Riordan and Pivowar discloses means for allowing a client to update constituent records stored in their virtual data island [Fig 11, 702].

Regarding claim 44, Ziarno, Riordan and Pivowar discloses wherein if the client has elected to share data, data from constituents records in the client's virtual data island are stored

Art Unit: 2161

in the data pool and the client has access to the results of the analysis of data in the data pool

[Ziarno, col 5, lines 30-40]

Regarding claims 51 and 52, Ziarno, Riordan and Pivowar discloses wherein if the client has elected to share data, data from constituent records in the client's virtual data island are stored in the data pool and the client has access to the results of the analysis of data in the data pool [Ziarno, col 5, lines 30-40]

4. Claims 18, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ziarno in view of US Pat. No. 5,665,952 issued to Ziarno (hereafter Ziarno 952).

Regarding claim 18, 30 and 31, Ziarno discloses the essential elements of the claimed invention except for login access for donors. Ziarno 952 discloses login access for donors [abstract]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ziarno to include login access for donors as taught by Ziarno 952 for the purpose of convenience in donating to a charitable organization [abstract].

Claims 19, 21 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ziarno and Riordan as applied to claim 1 above, and further in view of US Pat. No. 6,535,871 issued to Romansky et al (hereafter Romansky).

Regarding claims 19 and 34, Ziarno discloses the essential elements of the claimed invention except for a political organization. Romansky discloses a political organization [col. 2, lines 10-25]. It would have been obvious to one of ordinary skill in the art at the time the

Art Unit: 2161

invention was made to modify Ziarno to include a political organization as taught by Romansky for the purpose of preventing the revealing of top contributors to a political campaign [col. 2, lines 10-25].

Regarding claim 21, Ziarno discloses the essential elements of the claimed invention except for an opt-out field. Romansky discloses an opt-out field [col. 2, lines 10-25]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ziarno to include an opt-out field as taught by Romansky for the purpose of preventing the revealing of top contributors to a political campaign [col. 2, lines 10-25].

Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ziarno, Riordan and Pivowar as applied to claim 41 and further in view of Chan.

Regarding claim 42, the combination of Ziarno, Riordan and Pivowar discloses the elements of the claimed invention as noted above but does not disclose means for automatically updating a field in a virtual data island. Chan discloses automatic notification of an update option [col. 2, lines 60-64]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination of references to include automatic notification of an update as taught by Chan for the purpose of notification that a lock failure has occurred [col. 2, lines 60-64].

Response to Arguments

Appellant's arguments filed 11/16/2007 have been fully considered but they are not persuasive for the following reasons.

Art Unit: 2161

Appellant Argues

Appellant states in the paragraph joining pages 10 and 11:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some reasonable suggestion or motivation to modify the prior art reference or to combine reference teachings. Second, there must be a reasonable expectation of success of achieving the desired goals. Finally, the prior art references when combined must teach all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). Additionally, the courts have held that an invention is not obvious solely because it is composed of elements that are all individually found in the prior art. In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998). As described below, in this instance the test is not met.

Examiner Responds

Examiner is not persuaded. If applicant argues that there is no specific suggestion or teaching in the references to combine prior art, the examiner may respond that KSR forecloses the argument that a specific teaching, suggestion or motivation is required to support a finding of obviousness. See the recent Board decision Ex parte Smith, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing KSR, 82 USPQ2d at 1396) (available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071925.pdf>).

Appellant Argues

Appellant states in the second paragraph of page 11:

Art Unit: 2161

The cited references fail to teach or suggest at least this feature of the pending claims. In the latest Office Action, the examiner argues that Ziarno discloses the unique identifier by disclosing that a receipt is produced for a contribution by a contributor. Applicant respectfully disagrees with this interpretation of the disclosure of Ziarno.

Examiner Responds

Examiner is not persuaded. Examiner maintains that a contributor is uniquely identified because the contributor is given a receipt for tax purposes. Receipts for tax purposes are given at the end of the year (or soon thereafter) and show the total contribution for the year such that the contributor can complete Schedule A, Gifts to Charity on his/her tax return. The tax return is on an individual basis. Schedule A is included with Form 1040 – US Individual Income Tax Return.

Appellant Argues

Appellant states in the second paragraph of page 12:

Nothing in the cited portion of Ziarno teaches or suggests a unique identifier for an individual that is common across virtual data islands. The cited portion quoted above merely provides for a tax receipt to be generated for one or more donations at a single donation kettle.

Examiner Responds

Examiner is not persuaded. Examiner is unable to find the alleged “single donation kettle” in the paragraph cited by Appellant, i.e., Ziarno, column 9, lines 45-65.

To the contrary, Ziarno discloses in column 9, lines 48-50, “The receipt generator produces a receipt for a single donation or a plurality (emphasis added) of donations.” One of ordinary skill in the art understands from the above scenario that because the receipt generator

Art Unit: 2161

produces a receipt for a plurality of donations over an extended time period, the contributor must be uniquely identified such that the plurality of donations can be totaled and credited to the contributor for the purpose of producing a tax receipt. Therefore, each and every contributor must have a unique identifier such that each and every contribution can be identified for the purpose of providing a tax receipt at the end of the year.

To the contrary, Ziarno discloses in column 4, lines 20-35:

In yet a further embodiment, a first donation kettle 100 communicates contributor information, status information, and/or donation information to a second donation kettle 100 via communication circuitry 990 (Fig 1a) and a communication link 140.

Clearly, the communication of contributor information of a plurality of contributors, from a first donation kettle to a second donation kettle renders the claim limitation “the unique identifier for an individual being common across the virtual data islands.”

Ziarno disclose, column 8, line.13:

the contributor might authorize the charitable organization to use a secret identification number associated with his debit card in order to allow the organization to automatically obtain the donation without seeking subsequent authorization from the contributor.

Ziarno’s disclosure of a debit card account can be interpreted as “unique identifier for an individual.”

Ziarno discloses, column 9, lines 5-10:

Circuitry 903 then stores the keyboard information in storage 302 if necessary. By way of further example, the keyboard information may consist of a donation amount, an account number of the contributor, an authorization code, and the like.

Ziarno's disclosure of an account number of a contributor can be interpreted as "unique identifier for an individual."

Ziarno discloses, col 10, lines 11-20:

Donation kettle docking station 1999 allows for a card donation processor 160/240 to be docked. In one embodiment card donation processor 160/240 is communicatively attached to docking station 1999 to allow account and/or contributor information to be transmitted via docking station 1999 to, by way of example, terminal 120 (via communication link 140), to a card processor directly via communication link 140), to another donation kettle 100, and/or a combination thereof. In one embodiment a plurality of docking stations 1999 are networked.

Ziarno's disclosure of account and/or contributor information can be interpreted as "unique identifier for an individual." Ziarno's disclosure of networking a plurality of docking stations can be interpreted as "being common across the virtual data islands."

Ziarno discloses, col 5, lines 40-60

There are various types of statistical information that can be associated with a donation, a contributor, or usage of a donation kettle 100, and analyzed by statistical software routine. By way of example, one measure of the frequency of use of donation kettle 100 is the amount and/or number of donations generated at the donation kettle 100 and/or the time, date and number of contributors utilizing the donation kettle 100. Donation kettle 100, in one embodiment, or

Art Unit: 2161

terminal 120, in another embodiment, generates a report measuring the frequency of use of a particular donation kettle 100 or group of donation kettles 100. The donation habits of a contributor or a group of contributors, and the number of contributors as measured by the number of donations given, via the above described statistical software routine, and associated hardware. The routine might also include an interface with commercially available computer program, a customizable accounting program computer program, and/or a statistics computer program.

Ziarno's disclosure of the donation habits of a contributor or a group of contributors as analyzed by statistical software routine and associated hardware requires an "unique identifier for an individual; across the virtual data islands." One of ordinary skill in the art would expect the following definition for identifier, "Any text string used as a label, such as the name of a procedure or a variable in a program or the name attached to a hard disk of floppy disk."¹

Ziarno discloses, col 4, lines 42-47:

Donation kettle 100 stores a contributor's card account and donation information in data storage 302 (FIG. 1a).

Ziarno discloses. col 4, lines 47-50:

The card account of the contributor of the charitable organization is appropriately charged or debited the amount of the donation and the account of the charitable organization is augmented respectively.

Ziarno's disclosure of a contributor's card account can be interpreted as "unique identifier for an individual."

¹ Microsoft Computer Dictionary, Fifth Edition

Art Unit: 2161

Appellant Argues

Appellant states on page 13:

It is clearly only with improper hindsight, and only with benefit of appellant's disclosure, that there is any motivation to undertake the required modification of Ziarno to arrive at the present invention. Absent Appellant's disclosure, there is no motivation to combine the asserted references in order to arrive at Appellant's invention.

Examiner Responds

Examiner is not persuaded.

If applicant argues that there is no specific suggestion or teaching in the references to combine prior art, the examiner may respond that KSR forecloses the argument that a specific teaching, suggestion or motivation is required to support a finding of obviousness. See the recent Board decision *Ex parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing KSR, 82 USPQ2d at 1396) (available at

<http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071925.pdf>).

Furthermore, the reason for combining a reference to one or more references is clearly stated in above Office Action.

Furthermore, it is significant that all (emphasis added) limitations argued by Appellant are clearly anticipated by Ziarno. Ziarno is a statutory bar because Ziarno is a 102(b) reference.

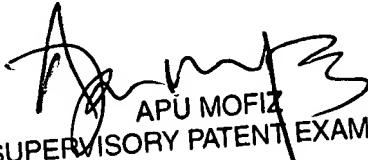
In view of the Appeal Brief filed on 11/16/2007, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth as detailed above.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:


APU MOFIZ
SUPERVISORY PATENT EXAMINER

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on Monday through Friday, 8:00 am - 4:30 pm.


Art Unit: 2161

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on (571) 272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Etienne LeRoux

12/18/2007


APU MOFIZ
SUPERVISORY PATENT EXAMINER